



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Alex MASHINSKY et al.

Serial No.: 10/098,667

Filed: March 15, 2002

For: System and Method for Facilitating Targeted
Marketing Over a Telecommunication NetworkExaminer: AL AUBAIDI, Rasha S.
Group Art: 2614

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

September 29, 2008

(Date of Deposit)

Edward M. Weisz

Name of Applicant, Assignee or Registered Representative

Signature

September 29, 2008

Date of Signature

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

SIR:

This is a Request for a Panel Review of Issues on Appeal in accordance with the Office Gazette Notice dated July 12, 2005. The present request is filed concurrently with a Notice of Appeal and a request for a two-month extension of time. No amendments are being filed with this request. Arguments supporting the Request begin on page 2 of the present communication.

REMARKS

This Notice of Appeal and Request is filed in response to the final Office Action dated April 30, 2008 and the Advisory Action dated August 29, 2008. Claims 1-3, 5, 6, 21-34 are pending. Claims 1 and 3 are the only independent claims. The issue for review is whether claims 1-3 and 5-6 are unpatentable over U.S. Patent No. 6,404,877 ("Bolduc") in view of U.S. Patent No. 6,282,563 ("Yamamoto"), claims 5-6 and 21-24 are unpatentable over Bolduc, and claims 25-34 are unpatentable over Bolduc in view of Yamamoto and further in view of Baker.

Independent claims 1 and 3

Bolduc discloses an automated toll-free search service, which employs a voice response unit to provide a list of toll-free telephone numbers and associated entities in response to a caller requesting information concerning a category of interest such as “clothing catalog services” or “bicycling catalogs” (see col. 2, lines 36-49). The information is announced and played for the caller. The caller then selects one of the toll-free numbers and the search service proceeds to launch a call to the selected toll-free number (see Abstract and Claim 1). Accordingly, two distinct telephone calls are made: one call from the caller to the toll-free search service, and then a second call from the search service to the toll-free number selected by the caller.

In contrast, the present invention facilitates targeted marketing over a telecommunications network. In one example of the use of the present invention, a central controller functioning as a local exchange carrier may receive a toll free phone call from a customer to an airline booking/reservation call center. In the process of switching the call to the appropriate network service provider, the central controller determines the identity of the terminating party (i.e. the airline call center) by querying a toll free directory database. Having determined the identity of the airline, the central controller next determines targeted marketing material based on the identity of the airline. In this case, the targeted marketing material may be a coupon for a competing airline good for any national roundtrip ticket booked with the next six months. The coupon is then provided to the customer. This may be accomplished e.g. via email, typical postal mail, the Internet, etc. (See page 3, lines 20-29 of the present application.)

The Examiner contends in the Response to Arguments in the final office action that a telephone call including routing information reads on Bolduc’s caller’s request for a product of interest, such as bicycling catalog, and that routing the telephone call to a called terminating party reads on Bolduc’s caller either saying or entering a DTMF command to confirm he/she want the bicycling catalog. Applicant respectfully disagrees. It is well known in the field of telecommunications that a telephone call has an originating party and a called party, where the “called party” is a person who (or device that) answers a telephone call. Billing records, better known as Call Detail Records are generated by carrier switches based on this definition. Thus, in the Bolduc system, the call from the caller 100 is routed by a local exchange carrier (LEC) 110 to the service node 190, which answers the call, i.e. the called party. And it is also well known in the art that a carrier such as the LEC 110 uses a telephony signaling protocol such as SS7 for setting up

the telephone call based on routing information including the called telephone number, which, in the Bolduc's system, is the toll free telephone number (e.g., 1-800-FIND-4-ME) of the service node 190. Accordingly, Bolduc's service node 190, not the referred telephone number subsequently provided by service node 190 to the caller, is the called terminating party with respect to the caller, as is well understood by the ordinarily skilled telecommunications engineers. In view of this definition, it is respectfully submitted that the pending claims do not read on Bolduc, or the cited secondary references of Yamamoto, and/or Baker (which were discussed in detail in Applicant's prior responses).

Assuming, *arguendo*, that the referred telephone number is the called terminating party, the Bolduc reference merely requires the search service to receive targeted marketing material. Thus, under the Examiner's interpretation of the claimed invention, Bolduc's search service is the originating party and the called terminating party is the referred telephone number connected by the search service. This interpretation leads to an unreasonable reading of the Bolduc reference because the claimed invention also requires the provision of targeted marketing material to the originating party, i.e. the search service. However, Bolduc does not disclose or suggest that the search service receives targeted marketing material based on the identity of the called terminating party. Bolduc does not and cannot provide such a motivation because it makes no sense, commercially or otherwise.

Accordingly, Bolduc, Yamamoto, and Baker, whether taken alone or in combination, fail to teach or suggest all of the limitations of Applicant's independent claims 1 and 3.

For the same reasons set forth above, dependent claims 2, 5, 6 and 21-34 are also patentable over the cited references.

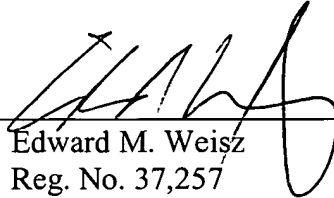
Conclusion

In view of the above remarks, the rejection of Applicant's claims should be withdrawn.

If any additional fees are required at this time in connection with the present application, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
COHEN PONTANI LIEBERMAN & PAVANE LLP

By

A handwritten signature in black ink, appearing to read 'E. Weisz', is written over a horizontal line.

Edward M. Weisz
Reg. No. 37,257
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: September 29, 2008